

7/30/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 24
EJS

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kabbalah Centre International, Incorporated,
assignee of Research Centre of Kabbalah

Serial No. 75/376,822

Peter E. Nussbaum of Wolff & Samson, P.A. for Kabbalah
Centre International, Incorporated, assignee of Research
Centre of Kabbalah

Kimberly Krehely, Senior Trademark Attorney, Law Office 107
(Thomas Lamone, Managing Attorney)

Before Seeherman, Quinn and Bottorff, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Research Centre of Kabbalah filed an application to
register THE KABBALAH CENTER and design, shown below, for
"educational services, namely, providing seminars and
courses on religion and spirituality."¹ The application and

¹ Application Serial No. 75/376,822, filed October 21, 1997, and
asserting first use and first use in commerce on January 30,
1991.

Ser. No. 75/376,822

mark was subsequently assigned to Kabbalah Centre International Incorporated.

In the first Office action the Examining Attorney required that applicant disclaim exclusive rights to the use of the words THE KABALLAH CENTRE. Applicant thereupon submitted a statement that "The mark has become distinctive of the services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." The Examining Attorney objected to the manner of the Section 2(f) statement because the design portion of the mark was deemed to be inherently distinctive. In response, applicant submitted an amended claim of acquired distinctiveness, stating "The 'KABBALAH LEARNING CENTRE' portion of the mark has become distinctive of the services through the Applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." It should be noted that this statement references THE KABBALAH LEARNING CENTRE, but the only wording in the mark, which is

the wording for which a disclaimer is required, is THE KABBALAH CENTRE. It is clear from both applicant's and the Examining Attorney's papers that the reference to THE KABBALAH LEARNING CENTRE was a typographical error, and that the Section 2(f) claim was made as to THE KABBALAH CENTRE. The Office has treated the claim to refer to THE KABBALAH CENTRE, as do we, and Office records reflect this.

The Examining Attorney has made final the requirement for a disclaimer of the words THE KABBALAH CENTRE, asserting that these words are generic for applicant's services. Moreover, the Examining Attorney asserts that even if the words were not generic, applicant has not established that they have acquired distinctiveness.

Applicant has appealed. The appeal has been fully briefed, but an oral hearing was not requested.

Preliminarily, we turn to objections raised by the Examining Attorney and applicant. The Examining Attorney has objected to the declaration of Peter Nussbaum attached to applicant's appeal brief, by which applicant attempts to present additional evidence in the form of three exhibits. The Examining Attorney also objects to the Board's consideration of a new argument and case citation made in applicant's brief which was not presented to the Examining Attorney during examination.

With respect to the additional evidence, the first exhibit is a copy of the assignment information regarding the application. Such information is not considered new evidence, and may be submitted at any time. Indeed, the Office encourages the filing of such information. See Rule 3.85, "The certificate of registration may be issued to the assignee of the applicant ... provided that the party files a written request in the trademark application by the time the application is being prepared for issuance of the certificate of registration..." See also TBMP § 502.01.

The remaining exhibits are two registrations of the applied-for mark, but for goods rather than services, which issued pursuant to Section 2(f) on January 2, 2001, and an e-mail message to Mr. Nussbaum from Lisa Kessler dated March 8, 2001 and reporting "February stats" "numbers for the website." Applicant explains that it submitted this information with its brief because it was not available at the time applicant's appeal was filed.

Trademark Rule 2.142(d) provides that the record in the application should be complete prior to the filing of an appeal and that, after an appeal is filed, if the applicant wishes to introduce additional evidence, it may request the Board to suspend the appeal and to remand the application for further examination. Applicant did not

follow the proper course, and we agree with the Examining Attorney that it would not be appropriate to consider this material now, at a point at which the Examining Attorney has no opportunity to submit evidence in response.

Accordingly, Exhibits 2 and 3 have not been considered.

We should also point out that even if the material had been properly made of record, it would not change our decision herein. The registrations are for audio and video tapes and for non-fiction books and newsletters and magazines featuring or in the field of religion and spirituality, and are specifically different from the services identified in the present application. As for the e-mail, aside from the fact that it is so cryptic that the information is unclear--e.g., it lists "hits" and "Visits," but does not indicate the difference between them, and there is no indication as to what the reference to "239,926 Pages" means--there is no authentication of the information. Mr. Nussbaum merely states, in his declaration, that it is a true copy of a portion of an e-mail correspondence he received from an employee of applicant, but he has not made any statement as to the accuracy of the information contained in the e-mail.

As for the Examining Attorney's objection to the so-called new argument raised by applicant in its brief, and

its citation of a case not cited during prosecution, that objection is overruled. Trademark Rule 2.142(d) refers to evidence in a case, not to argument or case citations.

In its reply brief, applicant, responding to the Examining Attorney's objection about the newly raised argument, asserts in a footnote that the Examining Attorney has presented new arguments, new evidence and a new ground for refusal, and requests that the Board "exclude these materials." We find that the Examining Attorney has not raised a new ground for refusal, but has merely augmented her argument regarding the genericness claim with her reference to de facto secondary meaning. Further, for the reasons stated above with respect to the Examining Attorney's objections to a newly-raised argument, applicant's objections are not well taken. Finally, with respect to applicant's assertion that the Examining Attorney has submitted new evidence, no such evidence was submitted with her brief. To the extent that the Examining Attorney, in her brief, made certain statements of fact, the probative value of those statements will depend on the supporting evidence which is of record.

We turn first to the Examining Attorney's assertion that THE KABBALAH CENTRE is a generic term for applicant's identified "educational services, namely, providing

seminars and courses on religion and spirituality." In support of this claim, the Examining Attorney has submitted definitions of the words "Kabbalah," "centre" and "center," as well as articles or excerpts of articles taken from the NEXIS data base, and an excerpt from a book by Adin Steinsalz, all of which include references to the word "kabbalah." The dictionary definitions are as follows:

Kabbalah

The 'received tradition' of Jewish mysticism, particularly those forms of mystical teachings which were developed in the middle ages in south-west Europe, and later on in the Galilean city of Safed in Palestine. The main text of the Kabbalah is the Zohar, written down in 13th century Spain. Unlike esoteric Judaism the Kabbalah teaches that the creation of the world took place through a series of emanations from the Godhead or *Ein Sof*. These emanatory structures, the 10 *sefirot* are the inner constitution of all reality as well as of the divine manifestation. They represent a finely balanced harmony enabling the flow of divine energy to sustain humanity and nature. Human sins affect this harmony, disturbing it and allowing the potential for evil within it to become active. The Kabbalah reinterprets all the main beliefs and rituals of Judaism in terms of its esoteric theology, which has pantheistic overtones. Its powerful images appealed to mystics and nonmystics alike. The most important development of Zoharic ideas was the Kabbalah of Isaac Luria (1534-72), which introduced a strong messianic element, and led to messianic movements

of a mystical type. [Internal citations omitted]²

cabala or cabbala also kabala or kabbala

1. Often Cabala. A body of mystical teachings of rabbinical origin, often based on an esoteric interpretation of the Hebrew Scriptures.

2. A secret doctrine resembling these teachings.

centre
Variant of center.

center
5.a. A place where a particular activity or service is concentrated: a *medical center* b. A point of origin, as of influence, ideas, or actions: a *center of power; a center of unrest*. C. An area of dense population: a *metropolitan center*.³

The following statements come from the various periodical excerpts:

Headline: Kabbalah for the Masses;
Judaic teachings turn mainstream

USA Today has even proclaimed that Buddhism is out, and Kabbalah is in.

"Kabbalah is a wisdom not a religion, so it doesn't matter what religion you consider yourself," said Merlin, who was raised Episcopalian.

"Sun-Sentinel" (Fort Lauderdale, FL),
March 15, 1998

² A New Dictionary of Religions, rev. ed. © 1995.

³ The latter three definitions are taken from The American Heritage Dictionary of the English Language, 3d ed. © 1992.

Some Jewish singles are into the study of Kabbalah Jewish mysticism a hot trend and new way to meet. [sic] "Daily News" (New York), February 11, 1998

Headline: Celebs embrace Jewish mysticism

The New Standard Jewish Encyclopedia says Kabbalah is "The mystical religious stream in Judaism .. (that) seeks to explain the connection between God and creation, the existence of good and evil, and to show the road to spiritual perfection." It was shrouded in mystery for centuries; now those of every faith attend classes worldwide.

"USA Today," September 20, 1996

There is no question that THE KABBALAH CENTRE is descriptive of applicant's educational services of providing seminars and courses on religion and spirituality. Applicant has stated that its educational and religious services "relate to the study of Jewish mysticism and spirituality, referred to by some as 'cabalistic study' or as set forth in the dictionary definition attached to the office action, as 'cabala', 'cabbala', 'kabala' or 'kabbala.'" Response filed August 16, 1999. Indeed, applicant has acknowledged the descriptiveness of THE KABBALAH CENTRE by its claim of Section 2(f) acquired distinctiveness.

However, the issue before us is not whether THE KABBALAH CENTRE is merely descriptive, but whether it is

generic. To prove that a mark is generic, the Office may not simply cite definitions and generic uses of the constituent terms of a mark, but must consider the meaning of the disputed phrase as a whole. **In re Dial-A-Mattress Operating Corporation**, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); **In re The Am. Fertility Soc'y**, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999).

Thus, we turn to the evidence showing use of the entire term "the kabbalah centre" or its equivalent spelling, "the kabbalah center." The Examining Attorney asserts that there are five pieces of evidence showing generic usage of the term "the Kabbalah center." We will examine each of them.

The article in the September 1, 1999 issue of "Tikkun" magazine includes the phrase "Kabbalah centers" in quotes, as follows:

Differing from the interest in Hasidism that centered mostly around Chabad in the preceding decades, this turn to Kabbalah has rather little to do with Jewish observance nor with nostalgia for a romanticized shtetl past (a past that many denizens of "Kabbalah centers" in fact do not share).

The fact that the author placed the words "Kabbalah centers" in quotes indicates that this is an unusual phrase, and would not be regarded as a generic term.

The remaining four pieces of evidence cited by the Examining Attorney relate to a single article, written by Rachel Graves for the Associated Press. This article was published in the "Calgary Herald" and in "The Commercial Appeal" (Memphis, Tennessee). (The articles differ in that the Calgary paper uses the British spelling of "centre," while the Memphis paper spells it in the American fashion, "center.") Portions of the article follow:

Chambers, who was raised a Roman Catholic, is director of the Karin Kabbalah Center in Atlanta, whose members practice a once-secret aspect of Judaism called Kabbalah. Students pray and practice meditation as the route to self-understanding.

Kabbalah was popular in Europe in the Middle Ages, when it was passed on to Jewish men over 40 who were deemed to have the maturity and pristine spirituality to handle mysticism's power.

Its followers claim that, through studying Jewish texts and achieving a more intimate relationship with God, Kabbalists can understand the hidden meaning of the Torah and can call on God to alter nature on their behalf.

Today, Kabbalah centers are popping up throughout the United States, teaching a hybrid version of this Jewish mysticism with no restrictions on age, gender or religion. Orthodox Jews dismiss the trend as a New Age fraud.

At the Atlanta center, the mostly Christian members will celebrate

Hanukkah—lighting candles and saying Jewish prayers—in conjunction with their Christmas Eve service, which also incorporates meditation and faith healing.

Rabbi Irving Greenberg, president of the Jewish Life Network in New York, said some of the centers are nothing but New Age imitations of Kabbalah. "People knock off Gucci and Armani because they're in," he says.

The Examining Attorney asserts that the owner of the Karin Kabbalah Center is using "Kabbalah Center" as a generic identifier in its trade name, and does not recognize any trademark significance in the term. The Examining Attorney also points to the article's author's use of "Kabbalah centers" in a generic fashion in the paragraph beginning with the word "Today." Further the Examining Attorney says that Rabbi Greenberg is quoted in the article as saying "some of the centers are nothing but New Age imitations of Kabbalah," and from this she concludes that "this implies 'Kabbalah center' is a generic term and that Rabbi Greenberg is referring to other Kabbalah centres in addition to those named in the article." Brief, p. 6.

There are certain problems with the conclusions the Examining Attorney draws from the articles. First, the quote from Rabbi Greenberg does not refer to "the centers."

That language was used by the reporter. Nor, in view of the statements by the Federal Circuit in Dial-A-Mattress and American Fertility, could we conclude that even a reference to "centers" would be evidence of generic usage of the phrase KABBALAH CENTRE.

Second, the reference to the Karin Kabbalah Center is not evidence that "the owner of the Karin Kabbalah Centre is using 'Kabbalah Centre' as a generic identifier within their tradename [sic]." Brief, p. 5. A newspaper article is not evidence of the statements made therein, and therefore is not evidence that there is a Karin Kabbalah Center in Atlanta.⁴ Even assuming that there is a Karin Kabbalah Center in existence, the fact that it includes the phrase "Kabbalah Center" does not necessarily show that "kabbalah center" is a generic identifier, or that the owner of that trade name regards it as such. As used in the article, the entire phrase "Karin Kabbalah Center" appears as a trademark or trade name.

Although a newspaper article is not evidence of the information contained therein, it can be used to show that the public has been exposed to the statements made in the

⁴ The hearsay problem which results in attempting to use a newspaper article to prove the truth of the statements made in the article is readily apparent in this case, with the different spellings of the name Karin Kabbalah Centre/Center in otherwise identical articles.

article, such that if a term is used generically it is possible to conclude that the public has come to view the term as generic. In this case, however, we cannot deem the public to have been exposed to the article which appeared in the Canadian newspaper. Thus, only the article which appeared in the Memphis newspaper can be deemed to have been exposed to consumers in the United States.

We agree with the Examining Attorney that the author of the Memphis article used "kabbalah center" in a generic fashion in the "Today" paragraph, and that her other reference to "the centers" in connection with the Rabbi Greenberg quote indicate the author's belief that this is a generic term.

However, we cannot consider this generic usage in just one article appearing in a Memphis newspaper to be sufficient to prove that the public understands THE KABBALAH CENTRE to be a generic term for the educational services identified in applicant's application. See **In re Merrill Lynch, Pierce, Fenner and Smith, Inc.**, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987). We hasten to add, though, that on a different record, such as might be adduced by a competitor in an opposition proceeding, we might arrive at a different result. However, on the record before us, and given that genericness must be shown by

clear evidence, we cannot conclude that THE KABBALAH CENTRE is generic.

Having found that the Office has not met its burden in proving that THE KABBALAH CENTRE is a generic term, we turn to a consideration of whether applicant has met its burden of proving that the term has acquired distinctiveness for "educational services, namely, providing seminars and courses on religion and spirituality."

Applicant has submitted the declaration of Karen S. Berg, the Secretary of Research Centre of Kabbalah, the original applicant. The declaration includes the following statements:

Applicant employs approximately 500 staff members, has 15 permanent branches worldwide (7 of which are located in the United States, and has an additional 25 satellite facilities throughout the world (including 13 located in the United States);

Applicant distributes throughout the United States and elsewhere throughout the world numerous promotional, marketing and advertising materials in connection with its educational and religious services;

Applicant has fulfilled its mission by providing education and information through classes, lectures, meetings, and the dissemination of information through books, magazines, brochures, newspapers, video tapes, audio tapes and the Internet to millions of people in the United States and abroad;

Applicant has conducted annual advertising campaigns continuously for at least the past decade and has expended substantial sums of money publishing advertisements in national publications such as The New York Times, The Los Angeles Times, The Jewish Journal, The Chicago Tribune and many others;

Applicant has also expended substantial sums of money conducting local advertising campaigns in cities throughout the United States and elsewhere throughout the world;

Applicant has advertised its goods and services provided and sold under the mark THE KABBALAH CENTRE & DESIGN through direct mail campaigns that have reached millions of people.

In addition to Ms. Berg's declaration, applicant has shown that it has establishments in Las Vegas, Chicago and Philadelphia, that the first two establishments are listed on its website, and that a listing for a "Power of Kabbalah" lecture at applicant's Philadelphia location appeared on the website for the "Philadelphia citypaper." Applicant also owns a registration for THE KABBALAH CENTRE, issued under the provisions of Section 2(f), for a "series of non-fiction books in the field of religion and spirituality; newsletters and magazines in the field of religion and spirituality."⁵

⁵ Registration No. 2,264,214.

As noted above, the burden is on the applicant to prove acquired distinctiveness. Moreover, the greater the degree of descriptiveness a term has, the heavier the burden to prove it has attained secondary meaning. **Yamaha International Corporation v Hoshino Gakki Co. Ltd.**, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In this case, the burden on applicant is a heavy one. KABBALAH is the name of the subject matter of applicant's educational services, and the term THE KABBALAH CENTRE immediately tells consumers that applicant provides a place for the study of this subject.

After having reviewed the evidence of record, we find that applicant has not met its burden of proving that the highly descriptive term THE KABBALAH CENTRE has acquired distinctiveness. Ms. Berg's declaration, although it mentions various promotional efforts, does not distinguish between applicant's efforts in the United States and abroad. Obviously, applicant must demonstrate that its mark has acquired distinctiveness in the United States, and any distinctiveness the mark may have acquired in other parts of the world will not support a Section 2(f) claim. Moreover, the declaration is very vague as to the specifics of applicant's efforts. The statements are made that applicant has expended "substantial sums of money" in local

and national advertising campaigns, but no actual advertising figures are provided, nor is there any indication of the numbers of any advertising materials distributed. Looking at the "representative materials" attached to Ms. Berg's declaration showing how applicant's mark is displayed, two appear to be photocopies of flyers advertising lectures in applicant's New York establishment, one on May 10, 1994 and the other on March 14 in an unspecified year. We cannot ascertain from applicant's submissions whether its promotional efforts have been minimal or far-reaching; obviously, the distribution of a limited number of flyers on a local basis does not have much impact in terms of proving acquired distinctiveness. The other materials include the photocopies of what appears to be packaging for two of applicant's videotapes, but although they show use of the mark on videotapes, they are not evidence of use of the mark on the services at issue herein. The remaining material may be pages photocopied from a brochure; it is not perfectly clear to us what they are. Even assuming they do represent a brochure promoting applicant's services, again we have been given no information as to when, where or the extent to which it has been distributed.

Ser. No. 75/376,822

As for applicant's registration for THE KABBALAH CENTRE which registered under Section 2(f), that registration is for books, newsletters and magazines, and these goods are sufficiently different from the services identified in this application that it cannot show that THE KABBALAH CENTRE has acquired distinctiveness for applicant's services. Cf. **In re Dial-A-Mattress Operating Corp.**, supra.

Decision: Although we find that THE KABBALAH CENTRE is not generic for applicant's identified services, we find that it is merely descriptive and that applicant has not met its burden of proving acquired distinctiveness. Accordingly, the requirement for a disclaimer of THE KABBALAH CENTRE is affirmed, and registration to applicant is refused. If applicant submits the required disclaimer within thirty days of the mailing date of this decision, the decision will be set aside, and applicant's mark will be published for opposition.